

REMARKS

Summary of Amendments Made

Although the applicants respectfully disagree with the nature of the previous rejections, in the interest of compact prosecution, the claims have been amended to encompass compounds wherein R¹ is methoxy. The applicants reserve the right to pursue the originally claimed subject matter in a divisional application.

Claims 1-18 are still pending. It is believed that no new matter has been added.

Certified Copy of Priority Document

A certified copy of the foreign priority document (EP 0 177 496) has been filed with this response.

35 U.S.C. 102(b) rejections

Claims 1 and 3 were rejected by the examiner as being anticipated over either Darsow (U.S. Patent 5,874,648) or Hall et al. (U.S. Patent 4,104,203).

The claims as amended now require that R¹ is methoxy which is not taught by either Darsow or Hall et al. and as such the rejection can now be withdrawn.

35 U.S.C. 103(a) rejection

Claims 1-18 were rejected by the examiner as being obvious over Darsow (U.S. Patent 5,874,648) and Hall et al. (U.S. Patent 4,104,203) in view of Robinson et al. (U.S. Patent 5,116,602). The applicants request reconsideration of this rejection in light of the amendments made and the arguments presented below.

After outlining the differences between the Darsow and Hall et al. references from the applicants' claimed invention, the examiner wrote that "...(a) the genus taught by Darsow include said 2-methoxy derivatives (see col. 1, lines 25-44, i.e. compounds wherein X = OCH₃)". However, this is incorrect.

Hydrogenation of the phenol to the corresponding cyclohexanol as outlined in col. 1, lines 25-44 of Darsow results in cleavage of the -OCH₃ moiety, i.e. CH₃OH (methanol) is a byproduct of the reaction. As such, Darsow does not teach a genus of isocamphylcyclohexanols which include 2-methoxy derivatives as recited in the applicants' claims.

In addition, the Hall reference also does not teach a 2-methoxy derivatives of isocamphylcyclohexanols. Hall teaches a cyclohexanol with a methoxy substitution (see e.g. col. 1, lines 50-60) but this compound does not also have an isocamphyl substitution as in the applicants invention.

As such, Darsow and Hall et al. collectively do not teach or suggest 2-methoxy derivatives of isocamphylcyclohexanols nor do they suggest a process for obtaining these compounds and given the teachings of Darsow, one of ordinary skill in the art would see that there are difficulties associated with synthesis of 2-methoxy derivatives when following their process steps (i.e. represents a "teaching away" from the applicants invention).

Therefore, the present combination of references do not render the applicants claimed invention as amended to be obvious and the examiner would be justified in withdrawing this rejection.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,
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CERTIFICATE OF MAILING

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (9 pages total) is being deposited with the United States Postal Service as Express Mail, Label No. EV328768785US, in an envelope addressed to : Hon. Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.:

Date: 7 July 2003

By: Vilma I. Fernandez